

Application No. 09/914,621
Amdt. dated 08/16/2004
Reply to Office Action of 12/16/2003

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REMARKS/ARGUMENTS

A Notice of Appeal has been filed in this application.

The Examiner objected to claim 1 on the basis that the "F" of the abbreviation "RSV F" was not identified. Claim 1 has been amended in this respect to identify the protein as the fusion protein.

The Examiner objected to claim 9 under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. In this regard, claim 9 has been deleted.

The Examiner noted that the oath or declaration is defective, since there were non-initialed and/or non-dated alterations to the address of Mary E. Ewasyshyn. In this regard, a substitute Declaration executed by Mary Ewasyshyn is enclosed. It is submitted that the Declaration can no longer be considered to be defective.

The Examiner objected to the disclosure on page 10, line 9, since there is no Brief Description for Figure 11 in the specification. The description on page 10 has been amended to refer to Figures 11A to 11I, as present in the drawings. It is submitted that the disclosure is no longer open to objection in this regard.

The Examiner rejected claim 3 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claim 3 has been amended to delete the term "first". It is submitted that claim 3 now fully complies with the provisions of 37 CFR 112, second paragraph, and hence the rejection thereof should be withdrawn.

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The Examiner rejected claims 1, 3 to 9 and 11 under 35 USC 102(a) as being anticipated by Li et al (J. Exp. Med.).

The Examiner noted that, if the Declaration submitted in response to the prior Office Action was signed rather than being unsigned, then this would be sufficient to overcome the rejection.

Submitted herewith are copies of the Declaration executed by the various inventors. Having regard thereto, it is submitted that the Li et al reference is not citable prior art under 35 USC 102(a).

Accordingly, it is submitted that the rejection of claims 1, 3 to 9 and 11 under 35 USC 102(a), as being anticipated, should be withdrawn.

The Examiner rejected claims 1 to 2 under 35 USC 103(a) as being unpatentable over Li et al (J. Exp. Med.) in view of Li et al (WO 99/04010) and Lee et al.

As noted above, the Li et al (J. Exp. Med.) is not citable prior art under any part of 35 USC 102 and hence is not citable prior art for the purpose of 35 USC 103, having regard to the executed Declaration submitted herewith.

Accordingly, it is submitted that the rejection of claims 1, 3, 6, 9 and 11 under 35 USC 103(a) as being unpatentable, should be withdrawn.

The Examiner rejected claims 1 to 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 25 of US Patent No. 6,083,925.

A rejection of obviousness-type double patenting may be overcome by the submission of a Terminal Disclaimer. Submitted herewith is a Terminal Disclaimer, executed by an attorney-of-record, disclaiming the term of the patent to be granted on this application which may extend beyond the term of USP 6,083,925.

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The Director is hereby authorized to charge the prescribed fee for this Terminal Disclaimer to our deposit account as indicated in the attached Fee Transmittal Form.

Having regard thereto, it is submitted that claims 1 to 11 are no longer open to rejection of obviousness-type double patenting of the claims of US Patent No. 6,083,925.

The Examiner rejected claims 1 to 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 7 of US Patent No. 6,486,135.

A rejection of obviousness-type double patenting may be overcome by the submission of a Terminal Disclaimer. Submitted herewith is a Terminal Disclaimer executed by an attorney-of-record, disclaiming the term of the patent to be issued on this application which may extend beyond the term of US Patent No. 6,486,135. The Director is hereby authorized to charge the prescribed fee for this Terminal Disclaimer to our deposit account as indicated in the attached Fee Transmittal Form.

Having regard thereto, it is submitted that claims 1 to 11 are no longer open to rejection on the ground of obviousness-type double patenting of the claims of US Patent No. 6,486,135.

Entry of this Amendment after Final Action is requested, in that the application thereby is placed in condition for allowance. In the event the Examiner considers one or more ground of rejection still to apply, then the Amendment nevertheless should be entered since the issues for appeal thereby are reduced and/or the claims are placed in better condition for appeal.

In the event the Examiner considers that further modification to the claim language is desirable to define the patentable subject matter thereof, the

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Examiner is requested to call the undersigned, Mr. Michael Stewart, collect, at the number given below, in order to arrive at mutually-acceptable language.

It is believed that this application is now in condition for allowance and early and favourable consideration and allowance are respectfully solicited.

Respectfully submitted,



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